

2



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,493	09/23/2003	Gil M. Vardi	CWIRE-001DIV	3988

1473 7590 12/15/2004
FISH & NEAVE LLP
1251 AVENUE OF THE AMERICAS
50TH FLOOR
NEW YORK, NY 10020-1105

EXAMINER

FOREMAN, JONATHAN M

ART UNIT PAPER NUMBER

3736

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/669,493

Applicant(s)

VARDI ET AL.

Examiner

Jonathan ML Foreman

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 15-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/9/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Information Disclosure Statement

The information disclosure statement filed 1/9/04 complies with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file, and the information referred to therein has been considered by the examiner as to the merits.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 15, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,144,959 to Gambale et al.

Art Unit: 3736

In regards to claims 15, 16 and 17, Gambale et al. discloses providing a guidewire having a core wire (10) with proximal section and tapered distal section (Figure 1), and plating gold onto a plurality of predetermined locations of the core (Col. 3, lines 28 – 30). However, Gambale et al. fails to disclose coating portions of the distal section of the core wire with a mask; exposing the distal portion beneath the mask at a plurality of predetermined locations; electroplating gold onto the predetermined locations; and removing the mask. However Gambale et al. discloses coating portions of a distal section of the guidewire with a mask; exposing the distal portion beneath the mask at a plurality of predetermined locations (Col. 5, lines 47 – 52); electroplating gold onto the predetermined locations (Col. 5, lines 35 – 37; Col. 4, lines 17 – 21); and removing the mask (Col. 5, lines 53 – 54). It would have been obvious to one having ordinary skill in the art to use the method as disclosed by Gambale et al. for plating gold at a plurality of predetermined locations of the distal section of the guidewire to plate gold at a plurality of predetermined locations of the distal section of the core wire to ensure that plating is only deposited on the desired areas.

4. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,144,959 to Gambale et al. as applied to claim 15 above, and further in view of U.S. Patent No. 5,437,288 to Schwartz et al.

In regards to claim 18, Gambale et al. fails to disclose coating the guidewire with a lubricious coating. Schwartz et al. discloses electroplating a distal portion of a guidewire with gold, and providing the guidewire with a lubricious coating (Col. 5, lines 51 – 56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a lubricious coating as taught by Schwartz et al. with the guidewire as disclosed by Gambale et al. in order to increase the mobility of the guidewire within a vessel (Col. 5, lines 43 – 46).

Art Unit: 3736

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,144,959 to Gambale et al. as applied to claim 15 above, and further in view of U.S. Patent No. 6,455,783 to Tsukada et al.

In regards to claim 19, Gambale et al. discloses removing the mask (Col. 5, lines 53 – 54), but fails to disclose chemically dissolving the mask. However, Tsukada et al. discloses an electroplating process wherein the mask is removed by chemically dissolving the mask (Col. 8, lines 55 – 56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to remove the mask as disclosed by Gambale et al. by chemically dissolving the mask as taught by Tsukada et al. so as to remove the mask in its entirety.

6. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,144,959 to Gambale et al. as applied to claim 15 above, and further in view of U.S. Patent Publication No. 6,636,758 to Sanchez et al.

In regards to claim 20, Gambale et al. fails to disclose forming indentations at the predetermined locations prior to the depositing of materials. However, Sanchez et al. discloses a guidewire wherein the radiopaque material (310) is deposited in previously formed indentations (Figure 3B). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the process as disclosed by Gambale et al. to include the step of depositing the radiopaque material in previously formed indentations as taught by Sanchez et al. in order to provide a smooth surface along the length of the core wire.

7. Claims 15, 16, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,865,767 to Frechette et al. in view of U.S. Patent No. 5,144,959 to Gambale et al.

In regards to claims 15, 16, 17 and 18, Frechette et al. discloses providing a guidewire having a core wire (10) with proximal section and tapered distal section (22), and electroplating plating gold

Art Unit: 3736

onto a plurality of predetermined locations of the core (Col. 4, lines 44 – 56). Frechette et al. discloses a lubricious coating (Col. 4, lines 44 – 58). However, Frechette et al. fails to disclose coating portions of the distal section of the core wire with a mask; exposing the distal portion beneath the mask at a plurality of predetermined locations; electroplating gold onto the predetermined locations; and removing the mask. However, Gambale et al. discloses coating portions of a distal section of the guidewire with a mask; exposing the distal portion beneath the mask at a plurality of predetermined locations (Col. 5, lines 47 – 52); electroplating gold onto the predetermined locations (Col. 5, lines 35 – 37; Col. 4, lines 17 – 21); and removing the mask (Col. 5, lines 53 – 54). It would have been obvious to one having ordinary skill in the art to use the method as taught by Gambale et al. for plating gold at a plurality of predetermined locations of the distal section of the guidewire to plate gold at a plurality of predetermined locations of the distal section of the core wire as disclosed by Frechette et al. to ensure that plating is only deposited on the desired areas.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 5,606,981 to Tartacower et al., U.S. Patent No. 6,068,623 to Zadno-Azizi et al. and U.S. Patent No. 6,761,708 to Chiu et al. disclose using electroplated gold for radiopaque markers on intraluminal devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

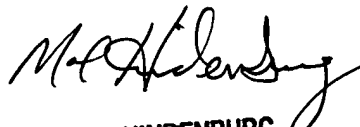
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726.

Art Unit: 3736

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JMLF



MAX F. HINDENBURG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700